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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,180	05/09/2002	Jean-Louis Mercier	08641-021001	6190

7590 01/11/2005

Fish & Richardson  
225 Franklin Street  
Boston, MA 02110-2804

EXAMINER
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VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,180

**Applicant(s)**

MERCIER, JEAN-LOUIS

**Examiner**

Mathieu D. Vargot

**Art Unit**

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 53-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53, 55, 56, 59, 62, 64, 66, 69-71, 73 and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by Schuler essentially for reasons of record noting the following. Applicant notes that Schuler does not teach that the molds would be in the shape of a “frame chosen by the wearer”. It is true that the reference fails to **explicitly** teach this aspect in that the term “frame” is not mentioned in the reference. However, as pointed out in the first action, such is considered to have been **inherent** in the process for the simple reason that one of ordinary skill would not mold, eg., a square lens in a rectangular mold, or an elliptical lens in a square mold. Clearly, in disclosing non-circular molds and gaskets, the applied reference is disclosing molding non-circular lenses. It would only make sense to mold a non-circular lens in a mold, which is of the same general **shape** as that of the frame the lens would ultimately be fitted in. Note that the instant claims call for shape, not necessarily size. Hence, some amount of surface grinding or cutting may be necessary to achieve the exact fit. This cutting or grinding, even if necessary, would not obviate the 102 rejection as such would have been within the scope of the instant claims.

2.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuler essentially for reasons of record noting the following.

While the applied reference may not explicitly teach that the shape is in the form of the frame chosen by the wearer, it is submitted that this would clearly have been obvious to one of ordinary skill in the art. Schuler teaches that the gasket cross section can be other than circular, such as rectangular, square or elliptical. To effect molding, the molds placed thereon would also have to be that general shape. If it is not inherent to mold the lens in the ultimate shape desired by the wearer—ie, the shape of a frame chosen by the wearer—then such certainly would have been obvious in order to reduce the amount of cutting and grinding to fashion the final lens. As pointed out supra, it simply would not make any sense to mold a lens with a desired non-circular shape and not mold such a lens in a mold which already has such a shape, wherein minimal grinding or cutting would be necessary. Hence, the mold would obviously be the same general shape as well as size of the frame in which the lens molded therein would fit. As already pointed out by applicant, Schuler desires there to be little front or rear surface grinding in fulfilling the prescription. Why then would the reference mention using a non-circular mold —to mold a non-circular lens—and not make the mold the same general size and shape of the lens, in essence the frame in which the lens is to be fitted?

3.Applicant's arguments filed October 14, 2004 have been fully considered but they are not persuasive. Most of applicant's comments have been addressed supra.

While the 102 has been maintained based on inherency, an additional 103 has been applied based on applicant's comments. Applicant's comments that the passage at column 7, lines 29-34 of Schuler teaches that the molded blank must be trimmed are noted, and the grinding and polishing is disclosed as being required "if necessary". Clearly, it would be very difficult to mold a lens without some additional trimming. However, as already pointed out, this does not obviate the fact that the lens mold is in the "shape of a frame chosen by the wearer". Additional trimming would merely mean that the size of the lens would have to be adjusted, not its overall shape due to frame constraints. This aspect is submitted to have been met by the applied reference, either through inherency or obviousness.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
January 10, 2005

*M. Vargot*  
Mathieu D. Vargot  
Primary Examiner  
Art Unit 1732

*1/10/05*